

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

LIGHTING & SUPPLIES, INC.,

Plaintiff,

v.

SUNLITE USA CORPORATION,
SPOTLITE AMERICA CORPORATION,
and HALSTON MIKAIL,

Defendants.

CIVIL ACTION

NO.: 1:14-cv-04344(JBW)

CONSENT JUDGEMENT FOR PERMANENT INJUNCTION

Recitals:

1. Plaintiff Lighting & Supplies, Inc. (hereafter “Plaintiff”) filed a complaint on July 17, 2014, thereafter amended on August 29, 2014 and October 7, 2014 against Defendants Sunlite USA Corporation and Halston Mikail. By further Order of the Court, the Complaint was deemed amended to add Spotlite America Corporation as an additional defendant (Sunlite USA Corporation, Spotlite America Corporation and Halston Mikail are hereafter referred to as “Defendants”).

2. Plaintiff alleges, *inter alia*, that it is the owner of U.S. Trademark Registrations No. 2,627,184 and No. 3,614,795 for the mark SUNLITE®, that it has used and promoted the mark since 1996, and that its exclusive right of use of the mark has been infringed by Defendants.

3. Defendants have denied the allegations and asserted certain affirmative defenses; nonetheless without admission of liability and to resolve Plaintiff’s claims insofar as the

Complaint seeks injunctive relief, reserving for trial all rights and defenses that may bear on any claim of damages, Defendants consent to the entry of this Permanent Injunction.

4. Plaintiff agrees to a jury trial to the extent it does not impede or limit the Plaintiff's right to an award of statutory damages under 15 U.S. Code § 1117(c) and/or an award of Defendants' profits under 15 U.S. Code § 1117(a)(1).

5. Defendants acknowledge the jurisdiction of this Court over them and the subject matter hereof; and waive the entry of findings of fact and conclusions of law pursuant to Rule 52 of the Federal Rules of Civil Procedure; without admitting any of the specific allegations of the Complaint except jurisdiction; and having waived any objections with regard to the right to appeal this Consent Judgment.

It further appearing that this Court has jurisdiction over the subject matter hereof:

IT IS HEREBY ORDERED, ADJUDGED AND DECREED that Defendants and any of their agents, servants, employees, officers, and all persons in active concert and participation with them are hereby permanently enjoined and restrained from directly or indirectly:

- a. Using the name or mark "SUNLITE" and/or "SUNLITE-USA", or any mark or design confusingly similar in any way, including, in connection with manufacturing, producing, distributing, promoting, advertising, offering for sale, and selling of any goods;
- b. Shipping, delivering, distributing, returning, transferring, or otherwise moving, or disposing in any manner any goods and products bearing the "SUNLITE" or "SUNLITE-USA" marks, or any mark or design confusingly similar thereto;
- c. Otherwise engaging in any other acts or conduct which would cause consumers to erroneously believe that Defendants' goods and products are sponsored by,

authorized by, or licensed by the Plaintiff, or are in any other way associated with Plaintiff;

- d. Possessing, receiving, manufacturing, distributing, advertising, promoting, offering for sale or selling any goods, labels, tags, logos, signs, and other forms of markings, any packaging, wrappers, pouches, containers and receptacles, and any catalogs, price lists, promotional materials and the like bearing a copy or colorable imitation of the SUNLITE mark;
- e. Representing themselves as being in any way connected with Plaintiff or sponsored by or associated with Plaintiff or Plaintiff's Registered Trademark;
- f. Using any reproduction, counterfeit, copy, or colorable imitation of the Plaintiff's Registered Trademark in connection with the publicity, promotion, sale, or advertising of any goods sold by either or both Defendants;
- g. Affixing, applying, annexing, or using in connection with the sale of any goods, a false description or representation, including words or other symbols tending to falsely describe or represent such goods as being of Plaintiff and from offering such goods in commerce;
- h. Using any trademark or trade name in connection with the advertising, promotion or sale of any goods which may be calculated to falsely represent such goods as being connected with, approved by or sponsored by Plaintiff; and
- i. Infringing Plaintiff's Registered Trademark; and,

IT IS FURTHER ORDERED that, within five (5) business days of this Permanent Injunction, Defendants shall recall any product that bears the "Sunlite" mark that are displayed for Menards' buyers located at Menards' corporate offices in Wisconsin; and

IT IS FURTHER ORDERED that, within five (5) business days of this Permanent Injunction, Defendants shall contact Google, Yahoo, and Bing, and shall provide a copy of the within Permanent Injunction and request that their search engines remove forthwith any cached search engine results to the website www.spotlite-usa.com (or any extension of that website) that appear in search engine result pages when searching the term “Sunlite USA” or “Sunlite-USA.com”, and, in the event that a search of “Sunlite USA” or “Sunlite-USA.com” on Google, Yahoo, and Bing still yields the website address www.spotlite-usa.com thirty (30) days after the search providers have been contacted to remove such links, the parties shall discuss and agree to additional reasonable measures to remove such links; and,

IT IS FURTHER ORDERED that, each party's right to litigate the extent, if any, to which the substance or contents of this Permanent Injunction should be disseminated to the jury is preserved.

Jack B. Weinstein
Senior United States District Judge

Dated: June __, 2015
Brooklyn, New York

STIPULATED TO:

SUNLITE USA CORPORATION
and SPOTLITE AMERICA CORPORATION

LIGHTING & SUPPLIES, INC.

By: Halston Mikail, sole-owner

By: Mordechai Kohn, CEO

HALSTON MIKAIL

Dated: _____

By: Halston Mikail, individually

Dated: _____

McDANIEL, PC
Counsel for Defendants

MENDEL ZILBERBERG & ASSOCIATES, P.C.
Co-Counsel for Plaintiff

By:

By:

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Dated: _____

Dated: _____

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